

**REMARKS**

These amendments and remarks are timely filed in response to the non-final Office Action dated October 6, 2006 (the "Office Action"). Although no fees are believed to be necessary, authorization is given to charge any necessary fees and credit any overpayments to Deposit Account No. 50-0951. At the time of the Office Action, claims 1-12 were pending. Claims 1-12 were rejected under 35 U.S.C. §112 and 35 U.S.C. §103. Claims 1-12 have been amended. No claims have been added or canceled. The rejections and responses thereto have been set out fully below.

**I. Objections to the Specification**

The disclosure was objected to because of a few reference numeral inconsistencies. The appropriate paragraphs have been amended herein to correct the inconsistencies.

**II. Rejections Under 35 U.S.C. §112 and Response Thereto**

Claims 1-12 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding the rejection of claims 1-3 and 10-12, the examiner indicated that these claims recite the limitation "pretzel configuration", and that it is unclear as to what type of configuration is meant by a pretzel configuration, since pretzels can be made to the form of a multitude of configurations. Regarding the rejection of claims 2-9 and 12, the examiner indicated that these claims begin with the phrase "the arrangement defined in claim..." and that claim 1 is directed to a food product and not an "arrangement."

As amended herein, claim 1 (from which claims 2-9 depend), claim 10, and claim 11 (from which claim 12 depends) do not recite "pretzel configuration." Claims 2-9 have been amended herein to recite "the food product defined in claim..." instead of "the arrangement defined in claim..." Support for the amendments to the claims can be found in Figures 1-7.

Accordingly, withdrawal of these rejections is respectfully requested.

### **III. Rejections Under Double Patenting and Response Thereto**

Claims 1-12 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10, 13 and 14 of co-pending application No. 10/642,541. The examiner argues that although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the co-pending application contain every element of claims 1-12 of the present application.

A terminal disclaimer in compliance with 37 CFR 1.321(c) and the required fee are submitted herewith to overcome this rejection. Withdrawal of the rejection is therefore requested.

### **IV. Rejections Under 35 U.S.C. § 103 and Response Thereto**

Claims 1-4 and 8-12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Coffee Cakes etc. in view of Berry et al. According to the examiner, it would be obvious to a person having ordinary skill in the art at the time the invention was made to modify Coffee Cakes etc. to place a plurality of dough pieces having a different composition on top of each other, as taught by Berry et al. for the purpose of making a singular food product that is the combination of a dough that has the taste of both a flavored white flour dough and a short crust pastry dough.

Claims 5-7 were rejected as being unpatentable over Coffee Cakes etc. in view of Berry et al., as applied to claims 1-4 and 8-12, and in further view of Wetzel's Pretzels. The examiner alleges that it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Coffee Cakes etc. in view of Berry et al. to comprise a dough product having a cinnamon flavor and a pretzel flavor, as taught by Wetzel's Pretzels for the purpose of providing a snack that caters to the varying tastes of consumers. According to the examiner, Wetzel's Pretzels provides "evidence of this since it is disclosed that there exists a pretzel that further comprises a cinnamon bun" and "motivation that the shape of a dough product and the flavoring on the dough product would

not provide a patentable feature, since the concept of flavoring a dough and shaping said dough is still the same."

The Office Action fails to make out a *prima facie* case of obviousness because the combination of references does not teach all the claim limitations present in amended claims 1-12<sup>1</sup>. Claim 1 (from which claims 2-9 depend), claim 10, and claim 11 (from which claim 12 depends) all recite "a first elongated dough member having a first preselected composition and formed to have a plurality of open spaces within said first elongated dough member...a second elongated dough member having a second preselected composition and formed into a spiral configuration and positioned within a first of said plurality of open spaces of said first elongated dough member..." None of Coffee Cakes etc., Berry et al., and Wetzel's Pretzels, nor the combination thereof, teach or suggest a snack food having the configuration and composition of both a pretzel and a cinnamon bun. Coffee Cakes etc. teaches baking danish or sweet dough in the shape of a pretzel. Wetzel's Pretzels teaches cinnamon roll dough also in the shape of a pretzel. Applicants disagree with the examiner's assertion that "Wetzel's Pretzels provides evidence of this since it is disclosed that there exists a pretzel that further comprises a cinnamon bun." Again, Wetzel's Pretzel's teaches a cinnamon roll or other sweet dough in the shape of a pretzel. It does not teach a pretzel that further comprises a cinnamon bun. Berry et al. teaches cinnamon rolls, sweet buns, sticky buns, and hot cross buns that, according to the examiner, "comprise a second and third elongated dough member...that is placed on top of said first dough member." None of these references teach or suggest a food item that has a first dough member formed to define three spaces with another dough member formed into a spiral and positioned within one of the spaces defined by the first dough member.

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<sup>1</sup> See MPEP 2143. ("To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 448, 20 USPQ2d 1438 (Fed. Cir. 1991)").

In addition to teaching or suggesting all claim limitations, to establish a prima facie case of obviousness, the prior art relied on, coupled with knowledge generally available in the art at the time of the invention, must provide the skilled artisan some motivation or incentive to modify a reference to arrive at applicant's invention<sup>2</sup>. See *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988); *In re Skinner*, 2 USPQ2d 1788, 1790 (Bd. Pat. App. & Int., 1986). None of the cited references, nor the combination thereof, provide any motivation for or suggestion to make a food product having "a first elongated dough member having a first preselected composition and formed to have a plurality of open spaces within said first elongated dough member...a second elongated dough member having a second preselected composition and formed into a spiral configuration and positioned within a first of said plurality of open spaces of said first elongated dough member..." as recited in independent claims 1, 10, and 11. Furthermore, these references, even when combined, certainly do not provide any motivation or suggestion to make a snack food having the configuration *and* composition of both a pretzel and a cinnamon bun. Based on the foregoing, applicants submit that none of the references cited above teach all the limitations of the present and amended claims, nor do the references suggest modifying their teachings to arrive at applicant's invention.

Although the claims are believed to be patentable over the cited art for the reasons set forth in the arguments above, the commercial success of the invention claimed in the current application further traverses any obviousness rejection. The Supreme Court, in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), sets forth the factual inquires for determining an obviousness rejection as:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

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<sup>2</sup> *Id.*

The M.P.E.P. § 2141 notes that secondary considerations, such as commercial success, long felt but unsolved needs, failure of others, etc., should be considered. The invention claimed in the current application has already achieved commercial success in the form of 7.2 million dollars in sales. As attested to in the 37 C.F.R. §1.132 Declaration attached hereto, the invention claimed in the current application has generated 7.2 million dollars in sales since 2003 for the current assignee, J&J Snack Foods Investment Corp. The existence of the 7.2 million dollars in sales for the invention claimed in the current application is a testament to its non-obvious improvements over the related art in satisfying a significant commercial need not previously addressed.

Accordingly, withdrawal of these rejections is respectfully requested.

**V. Conclusion**

Applicants submit that amended claims 1, 10, 11 and their respective dependent claims are patentable claims on multiple bases as set forth above. Namely, none of the cited references, either individually or in combination, teach or suggest a food product with all of the features recited in claims 1, 10 and 11. Further, the §1.132 Declaration of commercial success refutes any argument that the recited claims are obvious. In light of these multiple bases, Applicants submit that claims 1-12 are clearly patentable and thus, issuance of a notice of allowance is respectfully requested.

This submission is believed to be fully responsive to the examiner's request. The application is believed to be in condition for immediate allowance. If any issues remain outstanding, Applicant invites the examiner to call the undersigned if it is believed that a telephone interview would expedite the prosecution of the application to an allowance.

Respectfully submitted,

**AKERMAN SENTERFITT**

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